**DOCKET NO.: ALLE6002-100** **PATENT**
**17400CIP(OCU)**
**Serial No. 09/998,718**

## REMARKS

Upon entry of this amendment, claims 13, 14, and 17-27 will be pending. Claims 13, 18, 19, 26 and 27 have been amended for clarity, which is self-evident and is clearly supported by the specification at, for example, page 9, lines 5-8. No new matter has been added.

### I. Overview

(A) With regard to the rejection of claims 13, 14, 17 and 18 under §102(e) over Wheeler et al. (U.S. Patent No. 6,194,415, hereinafter "the Wheeler patent"), it is Applicants' belief that the rejection is overcome by Applicants' showing that the disclosure in the Wheeler patent (relied on by the Office Action to make the 102(e) rejection) **was Applicants' own work**. See MPEP 2136.05 and the Declaration by Dr. Wheeler discussed below.

(B) With regard to the rejection of claims 19-27 under §103 (a) over the Wheeler patent, it is Applicants' belief that this rejection is overcome by a showing that both the Wheeler patent and the present application are **commonly owned** at the time they were filed, thereby disqualifying the Wheeler patent to be cited as a prior art under 103(a). See 35 U.S.C. §103 (c).

### II. Rejection Under 102(e) Is Overcome By a Showing That the Disclosure Relied Upon for the Rejection Was Applicants' Own Work

The Office Action states that claims 13, 14, 17 and 18 are anticipated by U.S. Patent 6,194,415 ("the Wheeler patent"), under 35 U.S.C. §102(e). To make the 102(e) rejection, the Office Action relied on the disclosure of the Wheeler at column 8, lines12-22 and claim 1.

Specifically, the Office Action states that the present claims are anticipated by the Wheeler patent because the Wheeler patent teaches "the use of bromon[i]dine for the protection of neuronal tissue due to laser light. See column 8, lines 12-22 and claim 1."

It is established law that a 35 U.S.C. 102(e) rejection can be overcome by submitting a declaration under 37 CFR 1.132 to establish that the relevant disclosure is applicant's own work. See, In re Mathews, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); see also, MPEP § 2136.05.

**Accordingly, Applicants respectfully assert that the 102(e) rejection is overcome as the subject matter disclosed in the Wheeler patent that the Office Action relied on to make the rejection was invented by Dr. Larry A. Wheeler, who is also the inventor of the rejected claims 13, 14, 17 and 18.** In support of this assertion, Applicants submit herewith a Declaration of Dr. Larry A. Wheeler (enclosed). In the Declaration, Dr. Wheeler asserts that he is the inventor of the disclosure in the Wheeler patent that the Office Action relied upon to make the rejection against claims 13, 14, 17 and 18. Dr. Wheeler also asserts in the Declaration that he is the inventor of the subject matter in claims 13, 14, 17 and 18.

Thus, Applicants have overcome the 102(e) rejection of claims 13, 14, 17 and 18 over the Wheeler patent.

## III. §103 Rejection: The Wheeler Patent Is Not Prior Art as It Is Commonly Assigned to Allergan

The Office Action rejected claims 19-27 under 35 U.S.C. 103(a) as being obvious over the Wheeler patent. Applicants respectfully assert that the rejection under 103(a) should be withdrawn because the Wheeler patent cannot be used as a prior art against the present application. The Wheeler patent is not prior art against the present application because:

(1) the present application was filed after November 29, 1999;

(2) the Wheeler patent qualifies as a 102 (e) reference; and

(3) the present application and the Wheeler patent were commonly owned by Allergan, Inc., when the invention of the present application was made. See 35 U.S.C. 103 (c) and MPEP §706.02 (l)(2). The attached Declaration by the attorney of record, Mr. Stephen Donovan, provides a statement that the present application and the Wheeler patent were owned by Allergan, Inc., at the time the invention of the present application was made.

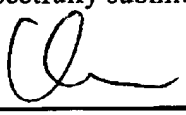
Since the Wheeler patent is not prior art, Applicants respectfully request that the rejections under 35 U.S.C. 103(a) be withdrawn.

## IV. Terminal Disclaimers

Claims 13, 14, 17 and 18 are rejected under the doctrine of obviousness-type double patenting over claim 1 of US Patent No. 6,194,415 and claim 7 of US Patent No. 6,465,464. Applicants submit herewith two terminal disclaimers regarding the two referenced US patents. Upon entry of the terminal disclaimers, the obviousness-type double patenting rejections are rendered moot. Accordingly, Applicants respectfully request that the rejection under the obviousness-type double patenting be withdrawn.

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and an early Office Action to that effect is earnestly solicited.

Respectfully submitted,



Quan L. Nguyen
Registration No. 46,957

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COZEN O'CONNOR
1900 Market Street
Philadelphia, PA 19103-3508
Telephone: 215-665-2158
Facsimile: 215-701-2057